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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,644	02/11/2005	Dorothee Hoischen	CS8336LeA 35,861	4956

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EXAMINER

KLINKEL, KORTNEY L

ART UNIT

PAPER NUMBER

1611

NOTIFICATION DATE

DELIVERY MODE

08/28/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/506,644

**Applicant(s)**

HOISCHEN ET AL.

**Examiner**

Kortney L. Klinkel

**Art Unit**

1611

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18-50 is/are pending in the application.
- 4a) Of the above claim(s) 22-41, 43-47, 49 and 50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-21, 42 and 48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-089)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date \_\_\_\_\_
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Acknowledgement is made of the remarks/amendments filed 5/4/2009. Claims 18-21, 27, 29 and 33 were amended. Claims 18-50 are pending in the instant Office action. Claims 22-41, 43-47 and 49-50 remain withdrawn for being directed to a non-elected invention. Claims 18-21, 42 and 48 are under consideration in the instant Office action.

As per MPEP 803.02, the Examiner will determine whether the entire scope of the claims is patentable. Applicants' elected species compound 2, of Table I on page 78 of the specification makes a contribution over the prior art, as noted in the first action on the merits dated 11/5/2008. The Examiner has extended the search to the full scope of compounds encompassed by formula (I), as currently amended in claim 18. These compounds make a contribution of the prior art teachings. Claims 18-21, 42 and 48 have been examined in full in the instant Office action.

### ***Withdrawn Claim Rejections***

#### ***Claim Rejections - 35 USC § 112***

The rejection of claims 18, 42 and 48 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in light of the claim amendments.

***Claim Rejections - 35 USC § 103***

The rejection of claims 18-21, 42 and 48 under 35 U.S.C. 103(a) as being unpatentable over Oya et al. (US 4986845) in view of Morris et al. (WO 95/31446, as per Applicant's IDS) is withdrawn in light of the claim amendments.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 18-21, 42 and 48 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. The claims lack utility because the specification has not demonstrated that the claimed compound of formula (I), and composition comprising the like has any use. Because the compound has no utility, the process of preparing a pesticide of claim 48, which depends on independent claim 18 also lacks utility. The specification prophetically states that "the compounds according to Preparation Examples 2, 4, 5 and 6 exhibit strong activity against weeds, and some of them are tolerated well by crop plants, such as, for example, maize and soya beans." but there is no support for this prophetic statement. See pages 158-159 of the instant specification, Examples A and B. It is noted that these pages make references to "the figures" (see lines 22 and 21 respectively), however no figures have been filed in the application.

***Claim Rejections - 35 USC § 112 1<sup>st</sup> Paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18-21, 42 and 48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to **use** the invention. The claims are directed to a novel compound of formula (I), a composition comprising the like and a method of preparing a pesticide by mixing one or more compounds of formula (I) with one or more extenders and/or surfactants.

In this regard, the application disclosure and claims have been compared per the factors indicated in the decision *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

All of these factors have been considered with the most relevant ones discussed below.

*The nature of the invention and the breadth of the claims.* The claims, as they read on to the elected species, are drawn to novel substituted aryl ketones of formula (I), as well as a pesticidal composition comprising one or more compounds of formula (I) and a method of preparing a pesticide by mixing one or more compounds of formula (I)

with one or more extenders and/or surfactants. The invention is complex in that the compounds of formula (I) are novel composition of matter. The specification *alleges* that these compounds show strong activity against weeds and that some of them are tolerated well by crop plants, such as, maize and wheat or soya beans. See pages 158-159 of the instant specification. No mention is made of which weeds were examined in the studies.

The state of the prior art and the predictability or lack thereof in the art. The state of the prior art is such that it involves screening compounds in order to determine whether or not they have the desired activity, which in this case is that of an herbicide. There is no absolute predictability even in view of the seemingly high level of skill in the art. The existence of these obstacles establishes that the contemporary knowledge in the art would prevent one of ordinary skill in the art from accepting that any compound, especially a novel compound, is an herbicide on its face.

The amount of direction or guidance present and the presence or absence of working examples. Pages 34-65 of the instant specification generally set forth the methods for preparing compounds of formula (I). Specific examples 1 and 2 at pages 75-76 detail the exact method of preparing two compounds of formula (I). Several compounds of formula (I) have been made according to these procedures as can be seen in Table 1 beginning at page 78, as evidenced by the logP values. Applicant has provided sufficient data suggesting how to make the claimed compounds.

However, the specification alleges that the claimed compounds have utility as herbicides, but no data has been provided to substantiate this assertion. Pages 158-

159 outline the steps one could take to determine whether or not the compounds of formula (I) have activity. Example A outlines a pre-emergence test and Example B, a post-emergence test. Example A states that preparation examples 2, 4, 5 and 6 exhibit strong activity against weeds, and some of them are tolerated well by crop plants such as maize and soya beans. Likewise, Example B states that examples 2, 3, 4, and 5 exhibit strong activity against weeds, and some of them are tolerated well by crop plants such as maize and wheat. No mention is made of what or which weeds were studied. These same pages refer to "the figures" (see lines 22 and 21 respectively), however, it is noted that no figures have been supplied in the application. Accordingly, the specification is completely devoid of data. Prophetic statements, such as those provided at the bottom of pages 158 and 159 are not considered objective data.

The quantity of experimentation needed. Given the lack of guidance in the instant specification regarding the utility of the claimed compounds, and the fact that the claims are directed to a novel composition of matter, undue trial and error experimentation would be required for one of skill to determine if the claimed compounds have utility and actually do what applicant alleges they do. Although sample test methods are provided, there is no implication that the claimed compound was actually tested to show that it in fact has the asserted herbicidal activity.

*Genetech Inc. v. Novo Nordisk A/S* (CA FC) 42 USPQ2d 1001, states that "a patent is not a hunting license. It is not a reward for search, but compensation for its successful conclusion" and "[p]atent protection is granted in return for an enabling

disclosure of an invention, not for vague intimations of general ideas that may or may not be workable". [emphasis added]

Therefore, in view of the Wands factors discussed above, to practice the claimed invention herein, a person of skill in the art would have to engage in undue experimentation to determine whether the claimed compounds have any utility, with no assurance of success.

### ***Conclusion***

Claims 18-21, 42 and 48 are rejected are rejected. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kortney Klinkel whose telephone number is (571)270-5239. The examiner can normally be reached on Monday-Friday 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached at (571)272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a



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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KLK

/Sharmila Gollamudi Landau/

Supervisory Patent Examiner, Art Unit 1611